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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/503,380	02/14/2000	Neil Owen Anderson	BAL6019P0190US	6523

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WOOD, PHILLIPS, KATZ, CLARK & MORTIMER  
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Chicago, IL 60661-2511

EXAMINER

BELL, KENT L

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 08/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/503,380

Applicant(s)

ANDERSON ET AL.

Examiner

Kent L. Bell

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on papers filed 9/9/05.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/9/05 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37-CFR-1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/20/00
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

K. L. Bell

**Detailed Action**

**Objection to the Disclosure**

**37 CFR 1.163**

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

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**35 USC 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention, and its

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

with which it is most nearly

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### Detailed Action

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 35 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

#### More Specifically:

A. The amendment to the specification page 1, line 1 – page 3, line 16, filed September 9, 2005, numbered as page 2, after line 4, before line 5, Applicant should set forth the Genus/species and the cultivar designation (MPEP 1605(c)).

B. The amendment to the specification page 1, line 1 – page 3, line 16, filed September 9, 2005, numbered as pages 2 and 3, Background of the Invention section, Applicant refers to three crosses. The first two crosses applicant refers to the cultivars as “parent” cultivars.

However, the third cross should be the only cross where the cultivars are “parent” cultivars. The

**Detailed Action**

first and second crosses could be stated as, for example, --A female or seed *Dendranthema weyrichii* plant -- and --A male or pollen *Dendranthema grandiflora* plant--. Correction and/or clarification is necessary.

C. The amendment to the specification page 1, line 1 – page 3, line 16, filed September 9, 2005, numbered as pages 2 and 3, Background of the Invention section, “from White Flower Farms” (one occurrence), “from Yoder Brothers, Inc” (four occurrences), and “a University of Minnesota” (one occurrence) should be deleted as these recitations constitute unwarranted advertising (MPEP 1610).

D. The amendment to the specification page 1, line 1 – page 3, line 16, filed September 9, 2005, numbered as page 3, lines 18-21, The location of asexual reproduction is unclear as it is uncertain where the asexual reproduction occurred. Applicant should delete “taken” as it is not understood whether applicant took the cuttings from St. Paul, Minnesota, U.S.A. and planted them in another area or took them and planted them in St. Paul, Minnesota, U.S.A. Correction is necessary.

⌘ **Detailed Action**

E. The amendment to the specification page 1, line 1 – page 3, line 16, filed September 9, 2005, numbered as page 4, lines 3 and 4, Rather than stating “flower petals” it appears --ray florets-- would be the more appropriate term to use in this instance.

F. The amendment to the specification page 1, line 1 – page 3, line 16, filed September 9, 2005, numbered as page 4, Table 1, line 10, Rather than stating “Flower” it appears --  
Page 5  
Inflorescence-- would be the more appropriate term to use in this instance.

G. The amendment to the specification page 7, filed September 9, 2005, numbered as  
⌘ page 6, line 12, Rather than stating “flowers” it appears --inflorescences-- would be the more  
appropriate term to use in this instance.

H. Page 4, lines 6-13, Applicant should set forth in the specification the age of the plant,  
⌘ when described.

I. Page 4, line 10, Applicant should delete “taken” as set forth in “D” above and also set  
forth the location where the plants were grown.

**Detailed Action**

J. Page 5, lines 6 and 18-25, page 6, lines 8, 19-23, 28, and 29, and page 7, lines 4, 6, 8, and 10, Applicant states color references are to the R.H.S. Colour Chart of The Royal Horticultural Society, London, England on page 4, lines 7 and 8. However, the designations set forth do not correspond to any designations in the RHS colour chart. Correction and/or clarification is necessary.

K. Page 5, lines 11-16, Applicant should set forth in the specification additional information relative to the instant plant including the typical and observed leaf shape.

L. Page 5, line 28, Applicant states "(SD)". It is not understood what applicant intends "(SD)" to mean. Correction and/or clarification is necessary.

The above listing may not be complete. Applicant should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

M. Page 5, lines 11-16, Applicant should set forth in the specification additional

N. Page 5, line 28, Applicant states "(SD)". It is not understood what applicant intends

O. Page 5, lines 11-16, Applicant should set forth in the specification additional

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## Detailed Action

### Claim Rejection

#### 35 U.S.C. 112, 1st & 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.

### Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kent L. Bell whose telephone number is (571) 272-0973. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anne Marie Grunberg, can be reached at (571) 272-0975.

The fax phone number for the group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-1600.

K. L. Bell

KENT BELL  
PRIMARY EXAMINER

*Kent L. Bell*